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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
NGUYEN, S

ART UNIT	PAPER NUMBER
2731	4

DATE MAILED:
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

☒ Responsive to communication(s) filed on _Mar 14, 1997_____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ____3____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) _1-32_____ is/are pending in the application.

　　Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) _1-32_____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

　　☐ All ☐ Some* ☐ None　of the CERTIFIED copies of the priority documents have been

　　　☐ received.

　　　☐ received in Application No. (Series Code/Serial Number) _____ .

　　　☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

　　*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _2,3_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- *SEE OFFICE ACTION ON THE FOLLOWING PAGES* ---

DETAILED ACTION

Specification

1.   Page 11, lines 4, the applicant should insert the application serial number between "U.S

Patent Application No." and "Docket no.".

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention
> thereof by the applicant for patent.

3.   Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Rondeau

(USP 5850433).

Regarding claims 1-2 and 24, Rondeau (See Fig 1-2, Col 1, lines 1 to Col 16, lines 12)

discloses the steps of receiving either a request for content from a client system which targets a

network server or an additional content inquiry from the client system. Providing, in response to

either receiving the request or the inquiry, additional content to the client system in other than the

requested content (Fig 1, Rondeau discloses a client system '18', ISP center '12' which comprises

a terminal server to allow client system to logon the Internet by using Internet protocol. The ISP

center receives a request from the client such as access to another web page by inputting an URLs

or a search request from ISP home page. The ISP center will provide a requested information and

an addition information such as advertising information which includes a telephone icon and

Hyper text link. If the client see the advertising information, he can access the web site by click on

hyper link or talk directly with a representative by click on telephone icon. "See Col 2, line 54 to

col 4, line 58").

Regarding claim 3, although Rondeau does not explicitly teach a step for providing the

addition content without altering the substance of the request content (generating an HTML with

request content in one frame and advertising information in one frame). However, such step is

inherently included in the system.

Regarding claim 4, although Rondeau does not explicitly teach a step of checking if the

URLs which corresponds to the addition content exists on the Internet and The ISP center then

provides the request content to client in response to the presence of addition content

corresponding to the network server. However, such step is inherently included in the system.

Regarding claims 5 and 12, it should have been explicit to one of ordinary skill in the art to

recognize that the request content must be received at the ISP before forwarding to the network

server by Internet.

Regarding claims 6-11, 13-15, 25 and 27-28, Rondeau discloses an addition content

includes an option for making a telephone call without requiring provision of a telephone number

by a user and termination of current client system to network communication; automatically

establishing a telephone to PSTN hand set; providing a URLS hyper text link (marked URLS) to the client system so that the client can access the web site of addition content by click on the hot spot such underline hyper link, image etc.... Furthermore, returning a marked version of the request to the client system; when the user clicks on the marked version, the ISP checks which proxy server has stored a current information and removing the marked version which provides at the current proxy server marked the request (Col 1, lines 1 to Col 16, lines 12);

Regarding claims 16-18, although Rondeau does not explicitly teach a step of returning a HTML page to client system which includes marked version of the request, a marked identifier of the additional content, the request, identifier of additional content, and addition content. However, such step is inherently included in the system. For example, when the client searches for a product, the ISP generates a HTML page which contains a marked version of the request such as highlight URLS or words and a marked identifier of additional content such as telephone Icon, Hyper text link host spot etc....

Regarding claims 19-23 and 26, Rondeau (See Fig 1) discloses a system for providing an on line directory service which comprises a database for storing the identifiers of addition content "Fig 1, 14, storing a plurality of directory listing including advertising information), a control logic for checking whether a request for content from a client system targets one or more network server or an addition content inquiry has been received (Fig 1, the terminal server "26" has a control logic to determining whether a request from client system '18' targets network server "28" or whether an additional content inquiry have been received by the terminal server and content

adding logic "14" which coupled to the control logic "28" for providing an identifier of additional content to the client system by generating HTML page including a request content and telephone icon which allows the client to dial the PSTN handset).

Regarding claims 29-32, Rondeau discloses a client system which comprises a control logic to receive the information from the first server (28), to send a search request to the first component (14), to subsequently send request to first server and send a second request to second component to obtain additional content based on the information which receives from the first component (After receiving a search report the client clicks on the telephone icon to speak withe representative or can click on the Hot link which has an address of the anther web sites to access advertisement is well known in the art by using HTML).

Regarding claim 32, although Rondeau does not explicitly teach a step of using a URL to identify a network server. However, such step is inherently included in the system.

4.   Claims 1-5, 10-21, 24 and 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Borman et al (USP 5890172) and Dekelbaum et al (USP 5838682, used as an extrinsic evidence to show the primary reference contains an enabled disclosure).

Regarding claims 1-5, 10-21, 24 and 28, Borman et al (See Fig 1-8) disclose a method which comprises a client system and Internet service provider including a database which contains the advertising information. The client accesses the web server of Internet service provider (Fig 7, 702, receiving information for content information for targeting server or inquiry addition information) and entering the searching information to query the advertising information from

search provider (Fig 1, 34); the database server (34, providing a request and addition contents to

client system) generates a HTML which contains the relevant information to a user. Borman et al

fail to teach an ISP which contains Internet server to allow the client system accessing the

Merchant Internet server. However, in the same field of endeavor, Dekelbaum et al disclose (Fig

1b) an Internet access provider which contains Internet server (214) to allow the client system

accessing the Merchant Internet server.

Regarding claims 29-32, Borman et (See Fig 1 and 7) disclose a client system which

comprises a control logic to receive the request content from first server (702), to send an inquiry

message to the search provider (reads on bridgeport) and to send a request to second server based

on the addition content which receives from the bridgeport by clicking on the hot link. However,

Dekelbaum et al disclose (Fig 1b) an Internet access provider which contains Internet server (214)

to allow the client system accessing the Merchant Internet server by clicking on the hot link.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims

under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35

U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6.   Claims 6-9, 22-23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Borman et al (USP 5890172) in view of Dekelbaum et al (USP 5838682).

Regarding claims 6-9, 22-23 and 25-27, Borman et al fail to discloses the addition content

comprising an option for making a telephone call to PSTN hand set without terminal current

session and phone number of the merchant. However, in the same field of endeavor, Dekelbaum

et al disclose the addition content comprising an option for making a telephone call to merchant

without terminate current session and provision of telephone number (Fig 6-8, discloses the client

access the web page of the merchant web site and clicking on the Hyper text link, a web auto

dialer will be activated and dial the PSTN handset).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify the method for retrieving information from the network which

contains the addition content with a telephone hot link as taught Dekelbaum et al into a method

for retrieving information from the network of Borman et al. The suggestion/motivation would

have been to allow the customer talking with the representative without disconnecting from data

session.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Vance (USP 5878219) disclose a method for accessing the information server from the

cline system and using the addition content from the search information to access another web

server on the Internet.

Shachar (USP 5764736) disclose a method for accessing a service provider web page

which contains telephone hot link to make a call to a PSTN handset without provision telephone

number and terminating the current session.

Chiu (USP 5752022) discloses a method for embedding an advertising information into

HTML page.

8.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner

can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Chi Pham, can be reached on (703) 305-4378.

The fax phone number for this group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding
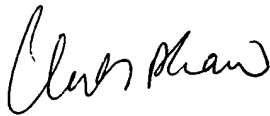
should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen
Art Unit 2731
June 28, 1999

CHI H. PHAM
SUPERVISORY PATENT EXAMINER
GROUP 2700